

REMARKS

Claims 1-11 and 13-18 are pending in the application.

Claims 1-11 and 13-18 have been rejected.

Reconsideration of the Claims is respectfully requested.

I. **EXAMINER INTERVIEW**

Applicant thanks the Examiner for holding the in-person interview with the Applicant's representatives, Mr. Peter Lando and Mr. Terry Daglow, on October 13, 2004.

II. **REJECTION UNDER 35 U.S.C. § 103**

Claims 3-5, 7-11 and 13-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Winkler (US 5,417,208) in view of Berkowitz, et al. (US 5,712,462). Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Winkler (US 5,417,208) in view of Berkowitz, et al. (US 5,712,462) and further in view of Adams, et al (US 5,350,404). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re*

Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Winkler recites an opening 47 cut in the insulator 20 to expose a wire 45. A flat conductive element 51 is welded to the wire 45. The conductive element 51 is electrically

connected via crimping and/or welding to the electrode 30a. Winkler, Col. 6, line 6 thru Col. 8, line 16. Thus, Winkler recites a single opening having a conductive element for electrically connecting the wire to the electrode (i.e., a single weld to the wire). In distinct contrast, Applicant's claimed invention provides two separate openings to expose the same underlying conductor and two conductive pads (one within each respective opening), with both conductive pads welded to the same conductor at different locations (i.e., two welds to the wire, each weld at a different location defined by removal of the insulator material).

Berkowitz teaches that existing resistive welding of titanium tabs to niobium pins in air does not produce consistent fusion welds. Col. 3, lines 30-31. Thus, Berkowitz teaches the use of an inert protective atmosphere (such as argon gas) during the resistance welding to produce superior welds. Col. 3, lines 41-52. There is no disclosure in Berkowitz of medical leads having a lead body with an insulator, forming multiple regions through the insulator by removal of the insulator to expose a conductor at two locations, providing a conductive pad within each region, electrically connecting the conductor to the respective conductive pads, and/or welding the two conductive pads at the two regions to an electrode. Berkowitz is limited to welding tabs to a pin. See, Col. 4, lines 476-53. Therefore, Berkowitz does not disclose two separate welds, with each weld at a different location (i.e., the two separate regions exposing the same conductor) and incorporating a conductive pad between the conductor and the electrode.

Applicant respectfully submits that there is no motivation or suggestion to combine Berkowitz with Winkler. However, even assuming that Berkowitz is combinable with Winkler,

the proposed Winkler-Berkowitz combination fails to arrive at Applicant's claimed invention. Since Berkowitz merely teaches resistance welding in an inert gas environment using reactive metals, the structure of a modified Winkler would be exactly the same - a single weld to each wire and not multiple welds to the same conductor through openings in the insulator at different locations.

Therefore, the proposed Winkler-Berkowitz combination fails to disclose, teach or suggest Applicant's claimed invention, as set forth in Claims 3-5, 7-11 and 13-18.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection of Claims 3-5, 7-11 and 13 -18.¹

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

¹ Dependent Claim 6 was further rejected in view of Adams. For the same reasons as set forth above, the proposed Winkler-Berkowitz combination fails to disclose, teach or suggest the Applicant's claimed invention, and Adams fails to cure the deficiencies in the Winkler-Berkowitz combination.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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